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Docket No.: GR 97 P 2659

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MAIL STOP: APPEAL BRIEF-PATENTS

By: [Signature]

Date: March 24, 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
Before the Board of Patent Appeals and Interferences

Applic. No. : 09/538,792 Confirmation No.: 7892  
Inventor : Vincenzo Scotto Di Carlo, et al.  
Filed : March 30, 2000  
Title : Method for Giving Notification of a  
Message to a Subscriber  
TC/A.U. : 2645  
Examiner : Joseph T. Phan  
Customer No. : 24131

Hon. Commissioner for Patents  
Alexandria, VA 22313-1450

BRIEF ON APPEAL

S i r :

This is an appeal from the final rejection in the Office  
action dated July 23, 2004, finally rejecting claims 1-14.

Appellants submit this *Brief on Appeal* in triplicate,  
including payment in the amount of \$500.00 to cover the fee  
for filing the *Brief on Appeal*.

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Real Party in Interest:

This application is assigned to Siemens Aktiengesellschaft of München, Germany. The assignment will be submitted for recordation upon the termination of this appeal.

Related Appeals and Interferences:

No related appeals or interference proceedings are currently pending which would directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

Status of Claims:

Claims 1-14 are rejected and are under appeal. No claims were cancelled.

Status of Amendments:

Claim 1 was amended in response to a 35 U.S.C. § 112, second paragraph rejection, after the final Office action in an Amendment under 37 CFR § 1.116, that was filed on December 27, 2004. The Primary Examiner stated in an Advisory Action dated January 31, 2005, that the after final amendment would not be entered of record because it allegedly raised new issues.

Summary of the Claimed Subject Matter:

As stated in the first paragraph on page 1 of the specification of the instant application, the invention

relates to a method for providing notification of a message to a subscriber who is registered with at least two message services.

Appellants explained on page 9 of the specification, line 2, that, referring now to the figures of the drawing in detail and first, particularly, to Fig. 1 thereof, there is seen a notification server MWIS which receives information from message services of a plurality of communication networks, namely an ISDN network (ISDN = Integrated Services Digital Network), a GSM network (GSM = Global System for Mobile Communications), a data network DN, and a private network referred to below as PISN.

Appellants further outlined on page 9 of the specification, line 11, that fixed ISDN telephones are provided as terminals in the ISDN network, and message services are available for text messages and voice messages. The GSM network has GSM cell phones (radiotelephones) as terminals. Message services available are a short text message service (SMS = Short Message Service) and various provider-dependent voice message services. Cord-bound or cordless telephones may be connected to the private network PISN; cordless telephones in particular according to the DECT standard (DECT = Digital Enhanced Cordless Communications). A short text message service is also

available for DECT telephones, and further message services may be provided depending on the performance features of the private network PISN. Finally, an e-mail service for electronic mail, with which any desired digital data may be sent, is made available in the data network DN. The data network DN may be a commercial data network. Computers which are connected locally to the data network DN may be used to access the e-mail service. In addition, it is possible to dial in to the data network DN by means of a telephone network using a portable computer.

As set forth on page 10 of the specification, line 6, the message services specified - and further services in alternative embodiments - indicate to the notification server MWIS any message which has newly arrived for a subscriber, by transmitting an appropriate information item to the notification server MWIS. The method of data transmission depends on the message service. For example, a message display from the GSM network is given by means of a specific message indicator (MWI = Message Waiting Indication) or by means of a short text message transmitted to the notification server MWIS. Such message indications may be transmitted in the form of an e-mail from the data network DN to the notification server MWIS. If the message server is connected to the ISDN network or another network by means of an ISDN line, suitable

signaling operations may be transmitted on the D channel. These and other communications possibilities are known per se and are to a certain extent standardized. For this reason they will not be described in detail here.

Appellants stated in the last paragraph on page 10 of the specification, line 24, that, in the first exemplary embodiment described here, the notification server MWIS receives from the individual message services merely the information that a new message is present. In addition, the notification server MWIS can determine the transmitting message service either from the port via which the information is received or from the information. In the first exemplary embodiment described here, the notification server MWIS does not receive any further information from the message services. In alternative embodiments, on the other hand, further information, for example message header information which contains details on the sender of the message, the reference, transmission date and time and so on is transmitted to the notification server MWIS. It is also possible for the message header information to be transmitted to the notification server MWIS only in response to a particular request by it.

As explained on page 11 of the specification, line 15, the notification server MWIS stores the information received from

the message services and generates for each message display a notification which indicates to the subscriber the presence of a message and indicates the message service in which this message is present. In the first two exemplary embodiments shown in Fig. 1, this notification is a GSM-SMS message which is transmitted via a network according to the CTM Phase 2 standard (CTM = Cordless Terminal Mobility) on a network to a dual-mode radiotelephone HS1 of the subscriber. The dual-mode radiotelephone HS1 is a combination of a GSM and a DECT telephone which the subscriber can carry continuously on his person. The CTM network comprises both GSM networks and DECT networks, and the GSM-SMS notification emitted by the notification server is automatically directed within these networks to the dual-mode radiotelephone HS1. The subscriber can therefore receive the notification within a very large spatial area. In response to receiving the notification, the subscriber can, if considered suitable or necessary, retrieve the message from the message service specified in the notification.

It is outlined on page 12 of the specification, line 10, that, referring now to Fig. 2, in the second exemplary embodiment the notification server MWIS receives the message indications from the message services in the manner already described. However, in contrast to Fig. 1, a plurality of subscriber

terminals to which the message notifications can be transmitted are provided here.

It is further outlined on page 12 of the specification, line 17, that, more precisely, the notification server MWIS can transmit a notification by means of a signaling operation on the ISDN-D channel via the ISDN network to a line-bound ISDN telephone TS1 of the subscriber. A notification transmission via the CTM network to the dual-mode radiotelephone HS1 already shown in Fig. 1 is likewise possible. However, in Fig. 2, the notification server MWIS does not access the CTM network directly, but rather the notification is output onto the Internet, and passed on from there as a GSM-SMS message to the CTM network. In addition, the notification server is configured to transmit notifications in the form of e-mail messages via the data network DN to a personal computer PC of the user. Finally, the notification server can also transmit notifications in the form of signaling operations, text or synthesized voice over the private network PISN to a DECT telephone HS1 and a fixed telephone TS2. The distribution of incoming notifications between the DECT telephone HS1 and the fixed telephone TS2 is carried out by means of the private network PISN.

Appellants described on page 13 of the specification, line 11, that, in the second exemplary embodiment described here, the notification server MWIS passes on, for each incoming message indication, a corresponding notification to all the connected terminals of the subscriber. The subscriber can thus always be reached if he has access to one of these terminals. In the case of the system shown in Fig. 2, the notification server MWIS is connected, to a certain extent, to the same networks on its input sides and output sides. In this case, the notification is not transmitted to that terminal from which the message of which there was notification originates.

It is outlined in the last paragraph on page 13 of the specification, line 22, that, in order to transmit the notification to the ISDN telephone TS1, a message indication (MWI) according to the ISDN standard is transmitted. The number of waiting messages and their type may be specified here. In the private network PISN, it is possible to transmit a message indication similarly to in the ISDN network if the private network PISN and the DECT telephone HS2 support the CAP standard (CAP = CTM Access Profile). In the GSM network, a short text message is, as already described, transmitted, so that a visual and/or audible message indication is also triggered on the GSM telephone HS1. In alternative embodiments, the notification can be transmitted at all



terminals which support a voice transmission, by means of a call set-up. The subscriber then receives a call in which he is informed of the presence of a message in a specific message service using synthetic voice.

Appellants stated on page 14 of the specification, line 12, that, in a further alternative embodiment, the notification is not transmitted to all the terminals of the subscriber but rather just to one terminal or to some of these terminals. The selection of the terminals can be carried out centrally, for example by means of a system administrator. However, it is also possible for the subscriber to make the selection himself. To do this, the subscriber can transmit a suitable control information item to the notification server from one of his terminals. The control information item can include the addresses (for example telephone numbers) of those terminals to which the notifications are to be directed. As an alternative, it is possible to provide for the notification server MWIS to direct future messages only to the terminal, or also to the terminal, from which the last received control information item originates. The subscriber can then register a terminal as a notification receiver by means of a simple selection of the notification server.

It is outlined on page 15 of the specification, line 4, that, in further alternative embodiments, in contrast with the representation of Fig. 2, other or additional communications paths and terminals are provided. In particular, possibilities are provided which permit the subscriber to interrogate at the notification server MWIS notifications which are present for him or her from any desired terminal. For example, it may be provided that the subscriber can dial the notification server MWIS from a public telephone and then receive the notifications by means of voice output. If the subscriber uses a mobile computer with a modem or an Internet access in order to access the notification server MWIS directly, the notifications are output in text form. In all these cases, an authorization check of the subscriber is, as a rule, necessary, for example by means of a password.

As set forth in the last paragraph on page 15 of the specification, line 19, the data flow in a notification server MWIS is illustrated in more detail in Fig. 3. As already described, the notification server MWIS has inputs E1, E2, ..., En for message indications of message services and outputs A1, A2, ..., An for notifications to terminals of the subscribers. The inputs and outputs are connected, as illustrated in Figs. 1 and 2 to different communications networks and message services. For each input and output, an

interface adapter device IWU (Interworking Unit) which performs the necessary adaptation functions for the exchange of messages with the message services is provided for each input and output in the notification server MWIS.

Appellants explained on page 16 of the specification, line 6, that the notification server MWIS in Fig. 3 is provided for use in a third exemplary embodiment of the invention in which at least some of the message services transmit a comprehensive message header information item to the notification server MWIS when a new message is present.

It is further explained on page 16 of the specification, line 12, that the message indications which are received from the message services are directed to a filter device FLT by the interface adapter devices IWU. The filter device FLT determines, according to predefined criteria or criteria which are set by the subscriber, the new messages for which a notification is to be output to the user. Depending on what types of information the message indications contain, such criteria may be, in particular, the priority of the new messages, the identity, determined by the name or the telephone number, of the transmitter or keywords in a title indication or reference indication of the message header information. For example, the subscriber can stipulate that no

notification is to be generated for messages from certain senders, or that a notification is to be generated only for messages from certain senders. In alternative embodiments, the filter device FLT can also order the incoming message indications according to their priority.

As stated on page 17 of the specification, line 4, the filtered message indications are then fed to a formatting device FMT. The formatting device FMT extracts from the message indications that information which the subscriber is to receive with the notification. This can be stipulated in advance or by the subscriber. For example, the subscriber can determine that he wishes to receive only the sender name and the title of the message. In alternative embodiments, the formatting device FMT can make available a plurality of formatting patterns which can be selected as a function of the capabilities of the terminal or of the terminals to which the notification is to be transmitted. For example it is possible to stipulate that a notification which is transmitted as a short text message will have more information than a message indication according to the ISDN standard. In further alternative embodiments, the terminals which are provided for the reception of the notification can be selected as a function of the information to be transmitted with the notification.

It is described in the last paragraph on page 17 of the specification, line 23, that the actual notifications are ultimately generated by a generating device GEN. Depending on the type of terminal to which the notification is transmitted, the generating device GEN produces a text notification or a voice notification in synthetic language from the information originating from the formatting device FMT. The message which is output by the generating device GEN is ultimately output via the interface adapter device IWU and the communications networks connected to the notification server MWIS to the desired terminal or the desired terminals of the subscriber.

References Cited:

US 6,333,973 B1          Smith, et al.          December 25, 2001

Grounds of Rejection to be Reviewed on Appeal

1. Whether or not U. S. Patent No. 6,333,973 to Smith ("**SMITH**") is available prior art against the present claims.
2. Whether or not the addition of the word "new" into claim 1 raised new issues.

3. Whether or not claim 1 is, presently, indefinite under 35 U.S.C. § 112, second paragraph.

Grouping of Claims:

Claim 1 is independent. Claims 2 - 14 ultimately depend on claim 1. Therefore, the patentability of claims 2 - 14 stand or fall with claim 1.

It is expressly noted that appellants reserve their rights to further pursue any of the dependent claims and/or to substantively argue the patentability of all claims over the **SMITH** patent in one or more continuing applications. The lack of separate patentability argumentation in this Brief is without prejudice and is based only on an effort by appellant to simplify the issues on appeal and to expedite the appeal.

Argument:

I. U. S. Patent No. 6,333,973 to Smith ("**SMITH**") is not available prior art against the present claims.

At primary issue in the present Appeal is whether a patent that was cited in a non-final action, and sworn behind by a 37 C.F.R. § 1.131 affidavit in the response to that non-final action, can be revived and cited again in a later, final action. More particularly, of primary importance to this

appeal is the question of whether U. S. Patent No. 6,333,973 to Smith ("**SMITH**") is citable against the present claims.

The present application is a continuation of PCT application PCT/DE98/02629, filed on September 7, 1998, which claimed priority from a patent application filed in Germany on September 30, 1997. The present application was filed in the United States Patent and Trademark Office on March 30, 2000, claiming priority back to the German application filed on September 30, 1997.

In the first Office Action issued in the present case, mailed on May 23, 2002, originally filed claims 1 - 12 were rejected as allegedly being anticipated by the **SMITH** patent. The **SMITH** patent has an earliest priority date of **April 23, 1997**, on which date it was filed in the United States Patent and Trademark Office.

On October 23, 2002, Applicants filed a response to the first Office Action, arguing the patentability of the claims, over the **SMITH** reference. However, prior to the mailing of a subsequent Office Action, Applicants filed a Supplemental Response on December 6, 2002. In the Supplemental Response, the Applicants filed a Declaration under 37 C.F.R. § 1.131, signed by both inventors and attesting to the fact that the

invention of the above-identified application was "reduced to practice" before April 23, 1997.

In order to corroborate the Declaration, Applicants enclosed with the Declaration, the Invention Disclosure (Erfindungsmeldung) that they prepared in the present case. The Invention Disclosure was dated, on each page of the disclosure, April 24, 1997 (a single day after the filing date of the SMITH patent) . The cover sheet submitting the disclosure to the Assignee's patent department was signed by both inventors on April 24, 1997. The Invention Disclosure was detailed, extending six typed pages, and included several graphics detailing the proposed invention. A representative of the Assignee marked the Invention Disclosure as received on April 25, 1997. Resultantly, as previously stated, a patent application was then filed in Germany on the subject matter of the Invention Disclosure on September 30, 1997.

In Applicants' Supplemental Response filed on December 6, 2002, Applicants' stated:

"The applied *Smith et al.* (US 6,333,973) has a prior art date (according to 35 U.S.C. § 102(e)) of April 23, 1997, i. e. one day earlier than the signature date of the Declaration/Disclosure. Since the enclosed declaration only "swears back" two days beyond the date of the enclosed Declaration/Disclosure, it is believed that no additional corroborating evidence in addition to the Declaration/Disclosure is required.



Consequently, it is believed that *Smith et al.* will not be available as prior art against the instant application."

A second Office Action, which was made final, was mailed in the present case on February 27, 2003. The Final Office Action was noted as being responsive to the communication filed on "11 December 2002", and thus was responsive to Applicants' Supplemental Response. In the Office Action, claims 1 - 12 were now being rejected under 35 U.S.C. § 102(e) based on a completely different reference (U. S. Patent No. 6,233,318 to Picard et al., "PICARD") that had been filed on November 5, 1996. The SMITH reference was not mentioned in the Final Office Action, nor was it alleged that Applicants' 1.131 Declaration or the proof offered was insufficient in any way. Rather, in the section of the Office Action entitled "Response to Arguments", the Examiner merely stated:

"3. Applicant's arguments with respect to claims 1 - 12 have been considered but are moot in view of the new ground(s) of rejection."

In response to the Final Office Action, Applicants' filed an Amendment under 37 C.F.R. § 1.116, in which the patentability of the claims were argued over the PICARD reference.

Subsequently, Applicants filed a request for continued examination (RCE) in the present case to further argue the patentability of the claims over the **PICARD** reference.

On November 21, 2003, a third Office Action was mailed in the present case. In the third Office Action, all claims again stood rejected based on **PICARD**. The third Office Action did not mention the **SMITH** reference, nor did it discuss any alleged insufficiency in Applicants' previously filed § 1.131 Declaration or the proofs offered therein.

In response to the third Office Action, Applicants amended claim 1 and further argued of the claims, now claims 1 - 14, over the **PICARD** reference.

In a fourth Office Action, which was made final, Applicants' claims (only claims 1 - 12 were listed) were now rejected, again, over the **SMITH** patent, which Applicant had previously sworn behind in response to the first Office Action.

In a response to the fourth Office Action, Applicants' referenced the 37 C.F.R. § 1.131 Declaration, previously filed by Applicants' on December 6, 2002. Applicants' additionally filed a further 37 C.F.R. § 1.131 Declaration, signed by inventor Vincenzo Scotto Di Carlo, attesting to his diligence

in reducing the invention to practice, culminating in the Invention Disclosure of April 25, 2004. Inventor Di Carlo additionally stated in that Declaration that the described invention was reduced to practice no later than April 25, 1997. Applicants again pointed out in their Response, that the invention disclosure of April 24, 1997, was dated only one day after the April 23, 1997 filing date of the SMITH patent.

In the Advisory Action following Applicants' response to the fourth Office Action, the Examiner stated:

"The request for reconsideration has been considered but does NOT place the application in condition for allowance because: Applicant did not provide sufficient reduction to practice evidence to overcome the prior art of record, Smith et al., Patent #6,333,973 filed April 23, 1997. The submitted Declaration 131 filed December 6, 2002 includes a proposed disclosure of the invention which merely shows that it was Conceived Proposal, Not Reduction to Practice as needed (i.e. test results, operational evidence, etc.). Not only does the submitted evidence shows [sic] only Conception, it is dated April 24, 1997, which is after the filing date of the Smith Patent. It is also noted that applicant's pending patent application was filed March 30, 2000."

Note that the Examiner mistakenly referenced the filing date of the present application as the priority date for this case. In the Advisory Action, in finding Diligence, the Examiner ignored the fact that the present case claims continuous priority from a parent application filed on September 30,

1997, barely over five months from the date the inventors signed the Invention Disclosure.

The facts of this case, which were available to the Examiner as early as December 6, 2002, when the Supplemental Response to the first Office Action was filed, are:

- 1) Both Inventors have sworn, in the declaration of November 2002, that the present invention was Reduced to Practice prior to the **April 23, 1997** filing date of the **SMITH** patent;
- 2) The current invention was written up in a comprehensive, typed Invention Disclosure, including graphic illustrations of the invention, which was dated on its face **April 24, 1997**, and which was signed by the inventors on **April 24, 1997**, only one day after the filing date of the **SMITH** patent.
- 3) A patent application, from which the present application claims priority, was filed on the substance of the Invention Disclosure on **September 30, 1997**.

Taking only the above three facts into consideration, it is clear that the present invention was conceived of prior to **April 23, 1997**, the filing date of the **SMITH** patent, and was diligently reduced to practice. Even if you ignore the fact

that the 1.131 declaration filed in 2002, attests to the fact that the invention was reduced to practice before April 23, 1997, diligence is shown by the filing of a patent application on the disclosed invention only about five months after the Invention Disclosure was signed, and the SMITH patent filed.

In the present case, the inventors swore in response to the first Office Action in the present case, that the present invention had been reduced to practice prior to the filing of the SMITH patent. The inventors provided as corroborating evidence, their own invention disclosure signed by them only one day after the SMITH patent. At the time the Examiner withdrew the rejection based on SMITH, he did not question the sufficiency of the proof of reduction to practice, or, even, the diligence, in the one intervening day between the inventors attested reduction to practice and the filing of the SMITH patent, or the one further day before the inventors signed the Invention Disclosure. Applicants maintain that the present invention was reduced to practice prior to the filing date of the SMITH patent. However, it is additionally clear that the proof offered by the Invention Disclosure offers proof of a reduction to practice no later than the day after the filing of the SMITH patent. That the inventors spent the day after the filing of the SMITH patent working towards the

signed copy of the Invention Disclosure, shows the Inventors diligence in the intervening days.

Additionally, **SMITH's** patent publication date of December 25, 2001 is subsequent to applicant's U.S. filing date of March 30, 2000 for the instant application. Because **SMITH** is not a statutory bar and its effective date as a reference is after the date that the present invention was conceived, and because the Inventors worked diligently towards the reduction to practice of the invention that they swore occurred prior to April 23, 1997, but which certainly occurred no later than April 25, 1997, **Applicants respectfully believe that the SMITH reference is unavailable as prior art against the present invention.**

Appellants ask that the rejections based on the **SMITH** reference be withdrawn.

**II. The addition of the word "new" into claim 1 did not raise new issues requiring further searching.**

In the Applicants' response to the third Office Action, which was non-final, then pending claim 1 was amended to read as follows:

"Claim 1: A method of notifying a subscriber of a plurality of message services of a message, which comprises:

indicating, with each of the plurality of message services, to a common notification server a presence of a new message for a subscriber on the respective message service;

selecting, by the subscriber, at least one terminal from a plurality of terminals of the message services; and

transmitting a notification, with the notification server, to the at least one selected terminal, in contrast to transmitting the message, the transmitted notification indicating that a new message is present and in which message service the new message is present." [emphasis added by Appellants]

As can be seen in lines 4 - 7 of the claim, the method of claim 1 indicated, for each of a plurality of message services, the presence of a new message. In doing so, as clearly indicated in lines 12 - 16 of the amended claim, in contrast to transmitting the message, a notification of the receipt of the new message was transmitted instead. It is apparent from a reading of the clear language of amended claim 1, that the message referred to in the phrase "in contrast . . . the message", could only be referring to the new message. Applicants assert that there is no other way to read that phrase. The system of the method had previously received a new message, and, in contrast to transmitting the message, a notification is transmitted indicating that a new message is present.

However, in the fourth Office Action, which was made final, claim 1 was rejected under 35 U.S.C. § 112, second paragraph because "the message" in line 13 of the claim was allegedly indefinite for not establishing antecedent basis.

In order to further prosecution, Applicants amended claim 1, as stated in the Response, "to even further clarify that claim". As such, Applicants amended claim 1 so that the referenced phrase "in contrast to transmitting the message" now read "in contrast to transmitting the new message". More specifically, Applicants amended claim 1, as follows:

"Claim 1 (currently amended): A method of notifying a subscriber of a plurality of message services of a message, which comprises:

indicating, with each of the plurality of message services, to a common notification server a presence of a new message for ~~[[a]]~~ the subscriber on the respective message service;

selecting, by the subscriber, at least one terminal from a plurality of terminals of the message services; and

transmitting a notification, with the notification server, to the at least one selected terminal, in contrast to transmitting the new message, the transmitted notification indicating that a new message is present and in which message service the new message is present."



In the Advisory Action, the Examiner refused to enter the proposed amendments because:

"The addition of the newly added term of "new" in line 11 of claim 1 is very critical to the interpretation of the claim since there are multiple new messages recited in the claim (lines 4, 11, and 12) and that the primary focus of the invention are these messages and notifications."

Appellant respectfully disagrees with the Examiner's stated reasons for not entering the claim amendment. Applicants maintain, as stated above, that from any reading of the claim, it was apparent that "the message" of the "in contrast" phrase, referenced the previously recited "new message" of that claim. In short, Applicants' believe that word **new**, added by amendment to line 13 of claim 1, was superfluous, as having already inherently been part of the referenced phrase.

From a simple reading of the claim, it can be seen that the addition of the word "new" to claim 1 in response to the fourth Office Action, did not raise new issues, but that from any reasonable reading of the claim prior to the most recent amendment, it would be understood that "the message" in the "in contrast" phrase referred to "the new message". As such, it is clear that the amendments made after the final rejection did not raise new issues, necessitating further consideration and/or search for which reason the Amendment would not be

entered. Appellants urge the honorable Board reverse the final rejection, as stated in the Advisory Action, and enter the Amendments made therein.

**III. Claim 1 is not indefinite under 35 U.S.C. § 112, second paragraph.**

In Section II. above, Appellants have set forth, in detail, how any reasonable reading of claim 1 would make it apparent to the reader that "the message" in the phrase "in contrast to transmitting the message" inherently and apparently refers to "the **new** message". Appellants incorporate by reference Section II., into this section in its entirety.

Because any reasonable reading of claim 1 leads the reader to the conclusion that "the message" in the "in contrast" can only refer to the previously recited "new message", if the amendments to claim 1 made in the last response, are never entered, Appellants maintain that the claim would not be indefinite. As set forth above, it is clear that claim 1 recites, in contrast to sending the message, transmitting an indication of the receipt of the previously recited new message.

As such, in the event that the claim amendments are not entered, Appellents request a decision that the claims are not

rendered indefinite by the failure to amend "the message" in the "in contrast" phrase of claim 1 to "the **new** message".

#### IV. Conclusion.

For the foregoing, Appellants believe that the **SMITH** patent is unavailable for use against the present claims. Additionally, Appellants believe that the amendment to claim 1, adding the word "new", did not raise new issues, but made even more clear something apparent from a plain reading of the previously presented claim. Further, since a plain reading of claim 1 led the reader to understand that "the message" could only be Appellants' previously recited "new message", Appellants believe that claim 1 was not indefinite under 35 U.S.C. § 112, second paragraph, for the lack of the word "new", even prior to the last amendment.

The honorable Board is therefore respectfully urged to reverse the final rejection of the Primary Examiner.

Respectfully submitted,



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Claims Appendix:

Claim 1: A method of notifying a subscriber of a plurality of message services of a message, which comprises:

indicating, with each of the plurality of message services, to a common notification server a presence of a new message for a subscriber on the respective message service;

selecting, by the subscriber, at least one terminal from a plurality of terminals of the message services; and

transmitting a notification, with the notification server, to the at least one selected terminal, in contrast to transmitting the message, the transmitted notification indicating that a new message is present and in which message service the new message is present.

Claim 2: The method according to claim 1, which comprises, if a message service indicates the presence of a new message, storing with the notification server the data originating from the message service, until the respective notification has been transmitted successfully.

Claim 3: The method according to claim 1, wherein the transmitting step comprises transmitting with the

notification server the notification to all terminals of the subscriber.

Claim 4: The method according to claim 1, wherein the transmitting step comprises transmitting with the notification server the notification to the at least one terminal selected by the subscriber from a plurality of terminals.

Claim 5: The method according to claim 4, wherein the subscriber selects the at least one terminal by transmitting a control information item from the respective terminal to the notification server.

Claim 6: The method according to claim 1, which comprises transmitting with each message service a message header information item to the notification server when a new message is present, and transmitting the message header information with the notification server at least partially to the at least one terminal selected, at least partially, to output the message header information.

Claim 7: The method according to claim 1, which comprises, in response to a request by the notification server, transmitting with each message service a message header

information item to the notification server, and transmitting at least partially the message header information item with the notification server to the at least one terminal selected to output the message header information.

Claim 8: The method according to claim 1, which comprises, in response to a subscriber request from any terminal, firstly performing an authorization check with the notification server and then transmitting the notifications present to the terminal.

Claim 9: The method according to claim 1, which comprises processing with the notification server the data originating from the message services for generating the notifications transmitted to the subscriber.

Claim 10: The method according to claim 9, wherein the processing step comprises selecting one or more processes from the group consisting filtering, ordering, and formatting the data.

Claim 11: The method according to claim 1, wherein the transmitting step comprises transmitting the notifications by means of a signaling operation to the at least one terminal of the subscriber.

Claim 12: The method according to claim 1, wherein the transmitting step comprises transmitting the notifications by means of a call set-up to the at least one terminal of the subscriber.

Claim 13: The method according to claim 1, wherein the transmitting step further comprises transmitting only a notification to the at least one previously selected terminal.

Claim 14: The method according to claim 1, wherein the transmitting step further comprises transmitting a notification only indicating that a new message is present and in which message service the new message is present.



Evidence Appendix:

A Declaration under 37 C.F.R. 1.131 was filed in this application together with a *Supplemental Amendment* on December 2, 2002. A second Declaration under 37 C.F.R. 1.131 was filed in this application together with the Amendment under 37 C.F.R. 1.116 on December 27, 2004. Copies of these declarations, and of the corroborating proof which was attached to each of those Declarations, is appended to this paper.

Docket No.: GR 97 P 265



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applic. No. : 09/538,792  
Inventor : Vincenzo Scotto Di Carlo et al.  
Filed : March 30, 2000  
Title : Method for Giving Notification of a Message to a Subscriber  
IC/A.U. : 2645  
Examiner : Joseph T. Phan  
Customer No. : 24131

DECLARATION under 37 C.F.R. § 1.131

The undersigned hereby declares:

- the invention was conceived at least as early as April 22, 1997
- I diligently worked towards a reduction to practicing the invention leading to an invention disclosure drafted on April 25, 1997
- the invention was reduced to practice no later than April 25, 1997.

Enclosed, as corroborating evidence is the Invention Declaration/Disclosure (*Erfindungsmeldung*) signed by the Inventor and dated April 25, 1997.

The undersigned declares that all statements made herein of his own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001 and such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Vincenzo Scotto Di Carlo  
Vincenzo Scotto Di Carlo

Dec 21<sup>st</sup>, 2004  
Date



97 P 2659 P

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231

By: \_\_\_\_\_

Date: \_\_\_\_\_

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Vincenzo Scotto Di Carlo et al.  
Applic. No. : 09/538,792  
Filed : March 30, 2000  
Title : Method for Giving Notification of a Message  
to a Subscriber  
Examiner : Joseph T. Phan  
Group Art Unit : 2645

D E C L A R A T I O N under 37 C.F.R. § 1.131

The undersigned V. Scotto Di Carlo and Egon Schulz hereby  
Vincenzo Scotto di Carlo Egon Schulz  
declare(s) :

The invention of the above-identified application was "reduced  
to practice" before April 23, 1997.

Enclosed, as corroborating evidence is the Invention  
Declaration/Disclosure (Erfindungsmeldung) signed by the  
Inventors and dated April 24, 1997.

Also enclosed, as corroborating evidence is the [notarized lab notice, etc.] signed by the Inventors and dated

\_\_\_\_\_.

The undersigned declares that all statements made herein of his own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001 and such willful false statements may jeopardize the validity of the application or any patent issued thereon.

V. Scott A. Carlo  
Vincenzo Scotto di Carlo

Date: 18.11., 2002.  
*Nov. 18<sup>th</sup>*

Egon Schulz  
Egon Schulz

Date: 28.11., 2002.



**Aktenzeichen der GR**

97 E 2130

5. Welche Dienststellen sind an der Erfindung interessiert? PN, ÖN
6. Wurde die Erfindung bereits erprobt (Durchführung von Versuchen, Anfertigung von Mustern)?  
☒ nein ☐ ja, Ergebnis: \_\_\_\_\_
7. Für welche Erzeugnisse ist die Erfindung anwendbar? Hicom Cordless E, Hicom 150, Hicom Cordless S, DECTLink
8. Ist die Anwendung der Erfindung vorgesehen?  
☐ nein ☒ ja, bei: Hicom Cordless E
9. Ist ein auf der Erfindung beruhendes Erzeugnis geliefert oder ist eine Lieferung beabsichtigt?  
☒ nein ☐ ja, (voraussichtlich) am \_\_\_\_\_; Bezeichnung des Erzeugnisses: \_\_\_\_\_
10. Ist eine Veröffentlichung der Erfindung beabsichtigt oder bereits erfolgt?  
☐ nein ☒ ja, (voraussichtlich) am 1998 in Buch, Zeitschrift: ETSI standards
11. Ist eine Mitteilung der Erfindung an Firmenfremde beabsichtigt oder bereits erfolgt?  
☒ nein ☐ ja, (voraussichtlich) am \_\_\_\_\_ an \_\_\_\_\_
12. Angaben zur Person des/der Erfinder(s) (Erfinder 1 – 4 hier eintragen. Für weitere Erfinder bitte Zusatzblatt beifügen):

Name	<u>311464</u>	Scotto di Carlo	Dr. Schulz	<u>247821</u>	
Vorname		Vincenzo	Egon		
akad. Grad/Titel/Beruf		Ingenieur	Dipl. Phy.		
Dienstanschrift mit Standort		PN AN 221, Mch H	PN AN 221, Mch H		
Tätigkeit/Stellung im Betrieb (z. B. Laborvorsteher u. ä.)		Software Entwickler	DL		
Hausanruf		089-722-36143	089-722-26858		
Staatsangehörigkeit		italienisch	deutsch		
Postleitzahl, Wohnort		81739 München	80993 München		
Straße, Haus-Nr.		Horwitz Str. 4/I OG	Wittenberger str. 3		
Geburtsdatum		15.11.60	06.04.55		
Abrechnende Personaldienststelle oder APD-Nr. *)		058	058		
Personalnummer *)		095562	095287		
13. Liegt die Erfindung auf a) Ihrem Arbeitsgebiet? b) einem anderen Arbeitsge- biet Ihres Arbeitgebers?	<input checked="" type="checkbox"/> ja <input type="checkbox"/> nein <input checked="" type="checkbox"/> ja <input type="checkbox"/> nein	<input checked="" type="checkbox"/> ja <input type="checkbox"/> nein <input checked="" type="checkbox"/> ja <input type="checkbox"/> nein	<input type="checkbox"/> ja <input type="checkbox"/> nein <input type="checkbox"/> ja <input type="checkbox"/> nein	<input type="checkbox"/> ja <input type="checkbox"/> nein <input type="checkbox"/> ja <input type="checkbox"/> nein	<input type="checkbox"/> ja <input type="checkbox"/> nein <input type="checkbox"/> ja <input type="checkbox"/> nein
14. Welchen Anteil an der Erfindung haben Sie?	50 %	50 %	%	%	
15. Wurde oder wird die Erfindung auch als VV gemeldet?	<input type="checkbox"/> ja <input checked="" type="checkbox"/> nein	<input type="checkbox"/> ja <input checked="" type="checkbox"/> nein	<input type="checkbox"/> ja <input type="checkbox"/> nein	<input type="checkbox"/> ja <input type="checkbox"/> nein	
16. Falls Sie die Erfindung als freie Erfindung ansehen, bitte begründen:					
17. Meines/unseres Wissens sind keine weiteren Personen an der Erfindung beteiligt.	<u>P. H. 1 Carl V. u. u.</u> <u>24/4/98</u>	<u>24/4/98</u> <u>scotto</u>			
	Unterschrift	Unterschrift	Unterschrift	Unterschrift	

Vermerke der ZFE GR

\*) Bitte aus Firmenausweis oder Gehaltsabrechnung entnehmen

## Aktenzeichen der GR

1. Welches technische Problem soll durch Ihre Erfindung gelöst werden?
  2. Wie wurde dieses Problem bisher gelöst?
  3. In welcher Weise löst Ihre Erfindung das angegebene technische Problem?
- BITTTE ANHANG SEHEN

4. Zur weiteren Erläuterung sind als Anlagen beigefügt:

- \_\_\_\_\_ Blatt der Darstellung eines oder mehrerer Ausführungsbeispiele der Erfindung;
- \_\_\_\_\_ Blatt zusätzliche Beschreibungen (z. B. Laborberichte, Versuchsprotokolle);
- \_\_\_\_\_ Blatt Literatur, die den Stand der Technik, von dem die Erfindung ausgeht, beschreibt; \*)
- \_\_\_\_\_ sonstige Unterlagen (z. B. Disketten, insbesondere mit Zeichnungen der Ausführungsbeispiele):

\*) Bitte Fotokopien oder Sonderdrucke aller zitierten Veröffentlichungen (Aufsätze vollständig; bei Büchern die relevanten Kapitel) mit vollständigen bibliographischen Daten beifügen.

## 1 What is the problem ?

In many networks as ISDN, Private networks (referred as PISN), Data networks etc., applications are available today, able to receive and store for an user messages of various form (voice, text, etc.). As soon as a message is received, it is immediately stored and the user is informed that a new message is ready to be delivered through an appropriate device (for example, PC, telephone, pager etc.). Therefore, „Message waiting indication“ (MWI) is forwarded to the user in some way (for example turning on a LED, activating a beep, showing a flashing icon etc.). The user is than supposed to access the application and get the message.  
Please refer to Figure 1 to recognize through some examples the variety of devices, applications and networks that support some form of MWI for each messaging service.

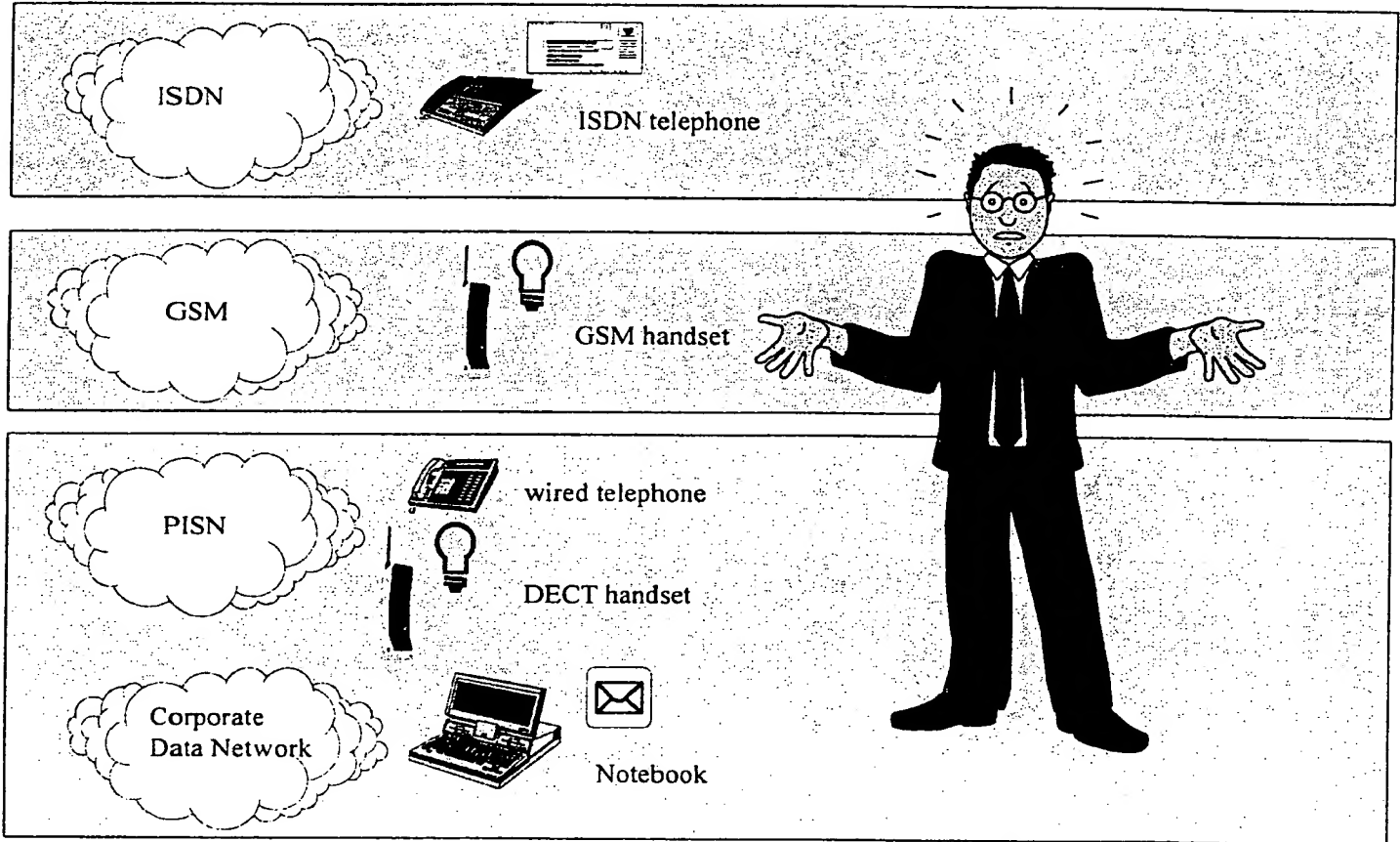


Figure 1 : Today's status

The problem is that all applications are totally independent each other. As a consequence, user, in order to be promptly informed that a new message arrived for him, should always have available either the proper device, or at least a device by which the desired application can be remotely accessed. However, some devices cannot be taken along (for example home wired phone), while other, though portable, doesn't work out of the relevant environment (for example an handset connected to a Pbx doesn't work out of the coverage area of that Pbx or out of the Corporate Network).

Therefore, it may happen that important messages are stored by the network for the receiving user, but the user cannot be informed of it because not reachable by MWI. Of course, the message, though important or urgent, is not delivered.

## 2 How it is solved today ?

The only possibility to solve the problem today is

- user „polls“ periodically each application which may have messages for him, or at least those that may have „urgent“ or important messages, if the application can be remotely accessed. Otherwise, the alternative is:



- user takes with him the required devices, or at least those that may deliver „urgent“ or important messages, if and when possible

Of course, this type of solution, for messages stored by „polled“ networks, is:

- not efficient, because urgent messages are in any case read with some delay
- costly, because each poll, made remotely, is usually subject to charges, regardless of the presence of new messages
- time wasting, because people spend time to poll „just in case“, without obtaining any useful information back

If user takes along the device, the above disadvantages disappear, but:

- not every device is portable
- taking along a lot of devices is not comfortable

The biggest problem is that the applications supporting messaging services are not integrated each other, except for few functionalities, for example, the possibility to send a GSM Short Message via Internet.

### **3 Solution**

#### **3.1 Principles**

The described solution consists in interfacing each application with a centralized „MWI server“, which forwards (optionally selectively) MWI to one or more devices, normally portable (see Figure 2). In this sense, MWI server has an „incoming side“, on which it receives from a network the information that a message is stored for the user, and an „outgoing side“, on which it forwards MWI to the selected networks.

Ideally, the server could forward MWI to a single device, if it is able to be reached everywhere (or fairly everywhere) and it is easily portable, so that the user carries it always and comfortably with him. In the future, the CTM Phase 2 standards will satisfy this requirement, allowing users having dual mode handsets (DECT/GSM) to transparently roam among public, private and business environment. As GSM networks are part of the complete CTM network, MWI server is simply required to send a GSM Short Message to be sure that the user is informed, wherever he is. This solution is quite simple to implement for MWI server, but it can be actually used only when networks supporting CTM Phase 2 standards will become commercially available.

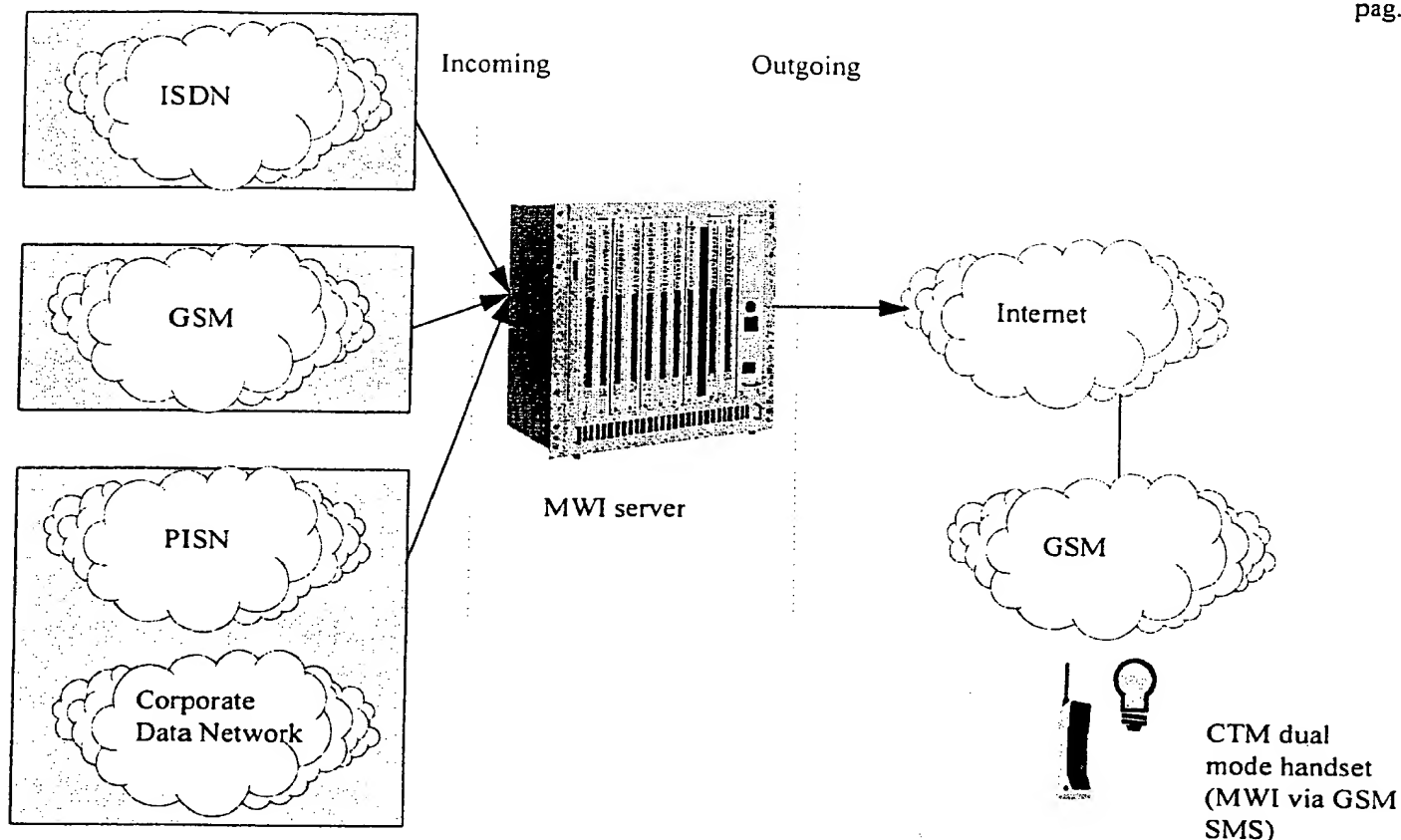


Figure 2 : Long term solution

### 3.2 Solution for todays networks

Todays networks don't support CTM standards. However, users can move today in a very wide area just having an GSM handset and a wireless phone at office, which we assume to be a DECT phone. An additional wired phone at office is connected to the same Pbx or Corporate Network of the wireless one. Normally, everyone has a phone at home, which we assume to be an ISDN phone. Finally, a data device (for example PC) is present certainly at office and often at home.

This means that the user is identified by:

1. a GSM number, to be reached in public areas
2. an office number (it could be assumed that the Corporate network hides the presence of two phones somehow sharing a single number), to be reached at office
3. an ISDN number, to be reached at home
4. one or more e-mail addresses. Solutions available in e-mail applications may automatically reroute messages and/or MWI among multiple addresses. For our purposes, just the case of a single e-mail address can be discussed

The applications that may delivered messages and the relevant required devices are listed in Table 1.

Application	Required device	Remarks
E-mail	PC or any data device	Many mailboxes, corresponding to different addresses, may be accessed through the same device. Notebooks can offer a good degree of mobility.
Voice mail (Office)	DECT Phone	Portable and fixed may share the same Voice Mail box. Limited mobility.
Voice Mail (Home)	ISDN phone	This device has no mobility.
Text Messages (GSM)	GSM phone	This is supported by Short Message Service (SMS) standardized in GSM. Normally, the MWI for GSM Voice Mail is implemented by means of GSM SMS itself, therefore doesn't need to be considered. Mobility is possible over a wide area.
Text Messages (DECT/Office)	DECT phone	This is supported by Short Message Service (SMS), under standardization in DECT application for Cordless Terminal Mobility (CTM). Wide mobility.

Table 1

The solution (see Figure 3) consists in connecting a MWI server on one side (incoming side) to each application capable of deliver messages to the user, and on the other (outgoing side) to the networks which are able to reach the user on a wide area (GSM, Pbx or Corporate Network, ISDN). The core function of MWI server consists in receiving on the incoming side from one of the networks the information that a new message is stored for the user, and forwarding MWI to all networks on the outgoing side.

Applications, may access MWI server on the incoming side via data networks (Corporate data network, GSM SMS), or directly, via appropriate interfaces over digital lines (ISDN, PISN). MWI server presents interworking functions to adapt to the different technological solutions and implementations of each application.

MWI server may internally support additional functions, as message filtering and MWI formatting (see Figure 4). Message filtering selects, according to criteria set up by the user or predefined, the messages that trigger the activation of MWI toward the networks connected on the outgoing side. Selected messages can be the high priority ones. Selection criteria can be the sender's identity (name or telephone number, for example) or some keywords in the message title, etc..

MWI formatting extracts from the informations received by MWI server only those that can or should be forwarded by MWI on the outgoing side. For example, only sender's identity and/or message title could be forwarded, depending on the capabilities of the network on the outgoing side.

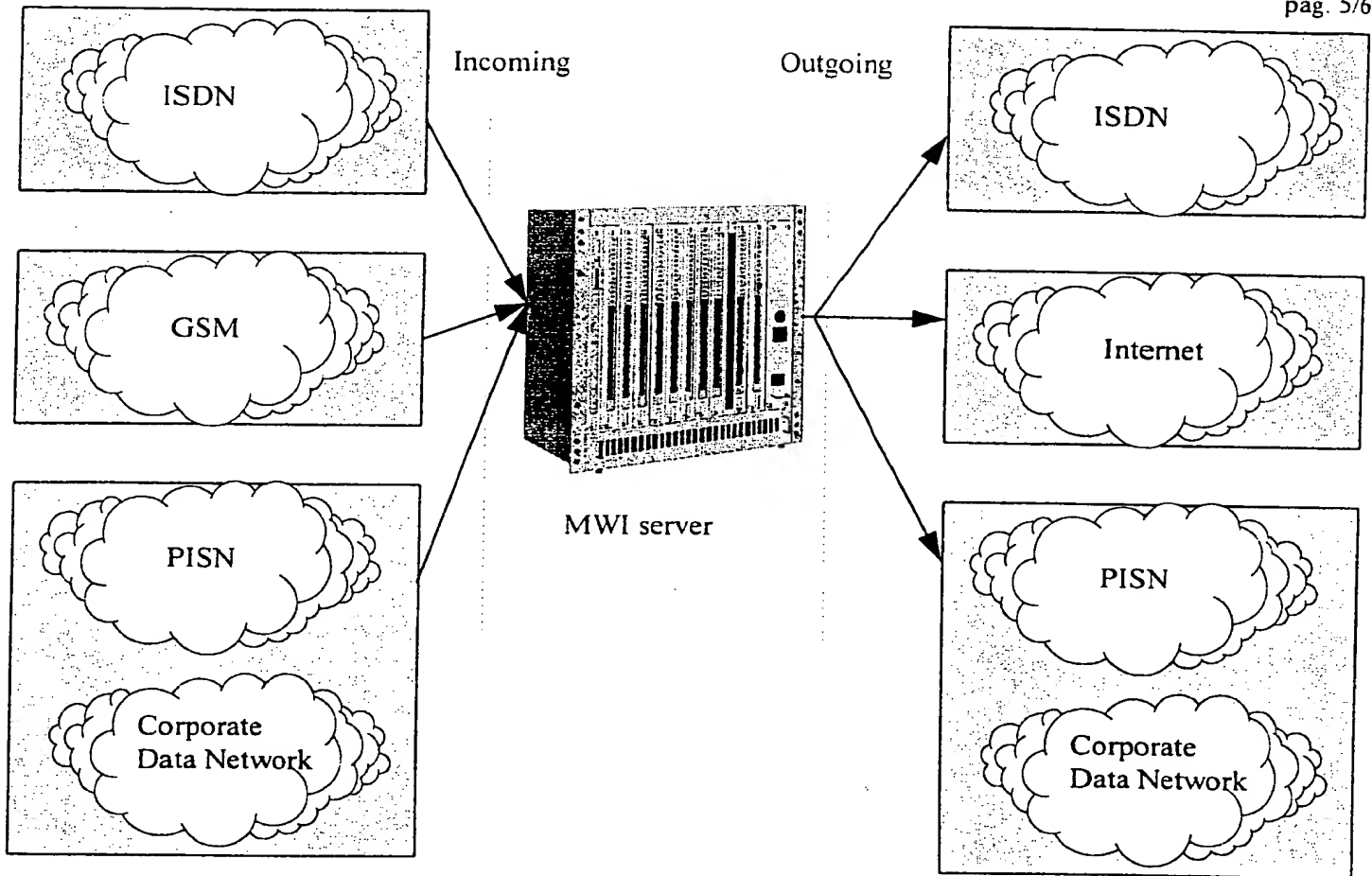
Finally, MWI server usually generates MWI on the outgoing side for all applications except for the one which signalled the presence of a new message. Networks supporting the relevant applications are accessed via an appropriate interworking function.

Depending on the outgoing interface, the method of activating MWI may differ.

For ISDN, a standard is available, which basically allows any endpoint, identified by an ISDN number, to activate MWI on a receiving user. It is possible to specify the number of messages waiting to be read and their type (voice, teletext etc.). MWI server is required to support an ISDN standard interface as interworking function.

For Private Networks, the CAP (CTM access profile) standard is available to trigger MWI on a CAP compliant DECT handset. This standard, strictly based on the ISDN one, has the same characteristics of the latter.

For GSM, MWI can be activated just sending a Short Message (SM) to the user's GSM number. Existing applications offer the possibility to send a SM via Internet. In this case, there is no need of a physical interface with GSM network, as a simple Internet access is sufficient.



**Figure 3 : Solution for todays networks**

With this solution, users need to carry along a dual mode CAP telephone, able to receive GSM SMS and CAP MWI. CAP MWI informs the user under PISN or home DECT coverage, while GSM SMS quite obviously under GSM coverage. Text messages include in principle e-mail, since MWI server may map e-mail in one or more GSM SMS. Provision of GSM SMS access via PISN is currently under standardization as well. In addition, two Siemens patents have been already registered.

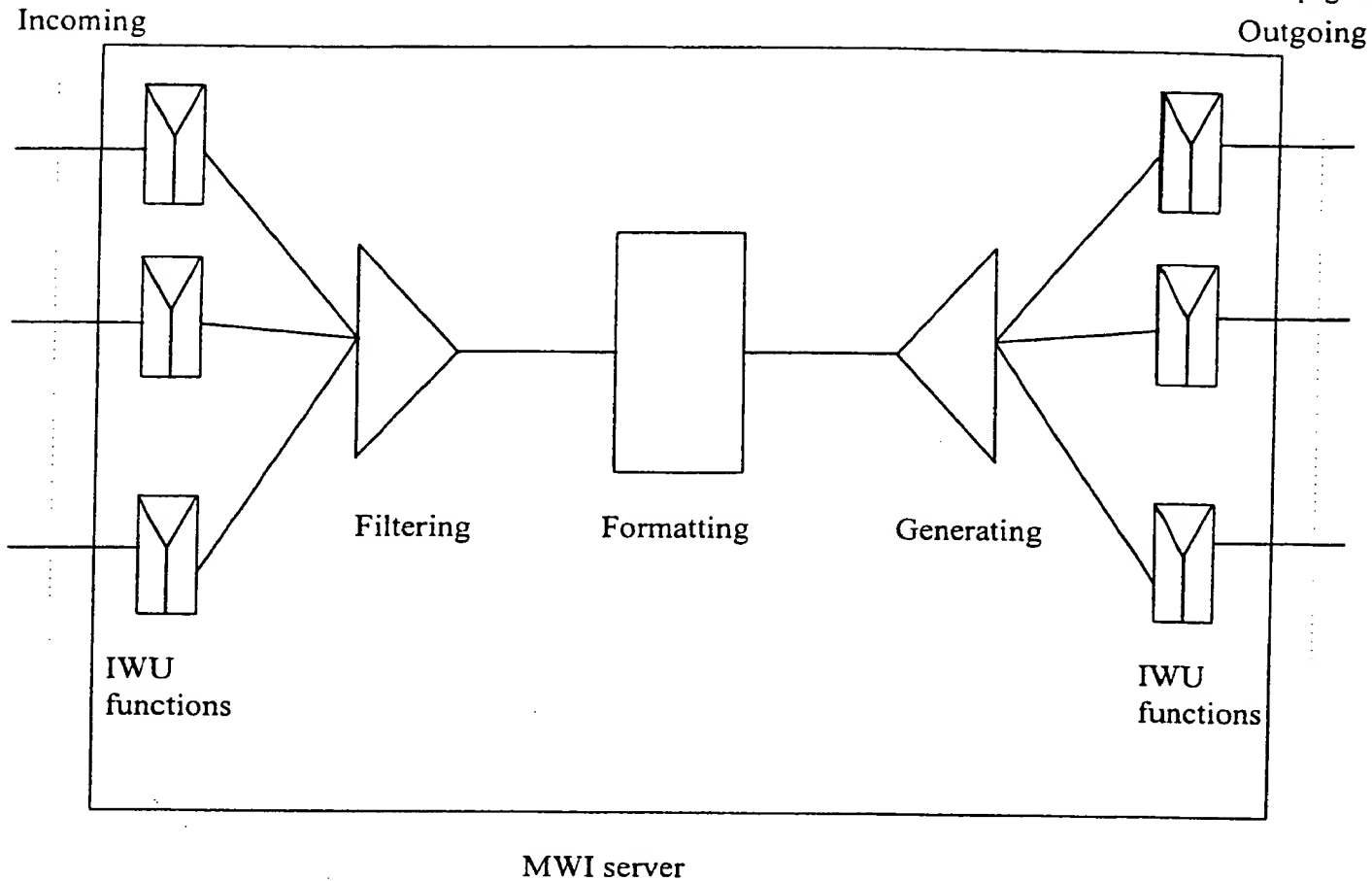


Figure 4 : MWI server internal functions

### 3.3 Notes

MWI server may operate in overlay with existing applications. This means that each application may be allowed to keep the existing mechanisms to signal MWI, and in addition it forwards the necessary informations to MWI server.

## 4 References

ISDN standard for MWI: ETS 300 745, ETS 300 751 etc.  
GSM SMS standards  
CAP (CTM Access Profile) DECT standard